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09/726,953	11/29/2000	Ricardo Guimaraes	155615-0018	1119
7590	07/28/2005		EXAMINER	
IRELL & MANELLA LLP Suite 400 840 Newport Center Drive Newport Beach, CA 92660			DAHBOUR, FADI H	
			ART UNIT	PAPER NUMBER
			3743	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/726,953  
Filing Date: November 29, 2000  
Appellant(s): GUIMARAES ET AL.

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Brian E. Jones  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 13, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,019,754

KAWESCH

2-2000

6,251,101

GLOCKER

6-2001

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in –

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Kawesch.

Kawesch discloses a method for performing an ophthalmic procedure on a cornea of a patient (Figs.1-5), comprising directing a flow of air above the cornea (200 of Fig.4, also see “over” in line 28 of col.5), from one side of the cornea to another side of the cornea (Figure 4), at a distance so that the cornea is not dehydrated by the flow of air (206 of Fig.4, also see “manually operated... manipulated to direct...flow of...air over” in lines 26-28 of col.5), creating a flap in the cornea (16 of Fig.2), moving the flap to expose a portion of the cornea (16 of Fig.3), ablating a portion of the exposed cornea with a laser beam (102 of Fig.4), moving the flap back onto the cornea (see “repositioning the flap” in line 45 of col.2), further comprising adjusting a flowrate of the flow of air (206 of Fig.4, also see “flow rate” in line 31 of col.5), further comprising adjusting a direction of the flow of air (206 of Fig.4, also see “manually operated... manipulated to direct...flow of...air over” in lines 26-28 of col.5).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawesch in view of Glockler.

Kawesch discloses a system used to perform an ophthalmic procedure on a cornea of a patient (Figs.1-5), comprising a light source that can direct a light beam onto the cornea of the patient (102 of Fig.4), and an airflow module (200 of Fig.4) that can direct a flow of air above the cornea of the patient (see "over" in line 28 of col.5), from one side of the cornea to another side of the cornea (Figure 4), at a distance so that the cornea is not dehydrated by the flow of air (206 of Fig.4, also see "manually operated... manipulated to direct...flow of...air over" in lines 26-28 of col.5), further comprising a control console that is coupled to the airflow module (200 of Fig.4, also see "control" in line 57 of col.3), wherein the light source includes a laser (see "laser" in line 24 of col.4), wherein the airflow module creates a laminar flow of air (200 of Fig.4, also see "over" in line 28 of col.5), wherein the airflow module includes an adjustable blade (206 of Figure 4).

Regarding claims 1, 3-11 Kawesch lacks a patient support table. Glockler discloses a patient support table (Fig.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the feature taught by Glockler, in the device of Kawesch, because Glockler teaches that "the head of patient P will be firmly supported on and preferably restrained by an operating table" (see lines 62-63 of col.5 of Glockler).

Regarding claims 2, 8-11 Kawesch lacks a portable stand that supports the airflow module. Glockler discloses a portable stand (see wheels in Fig.1). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the feature taught by Glockler, in the device of Kawesch, because it would allow for the device to be used in alternative locations, and also because, Kawesch teaches that “drying device 200 may be integrated into a complete laser-based vision surgery apparatus or it may be a separate, retrofit unit” (see lines 17-19 of col.5 of Kawesch).

**(10) Response to Argument**

Applicant argues that Kawesch does not disclose an airflow module that can direct a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air. Kawesch’s air flow module, however, does meet this limitation, because of Applicant’s usage of the word “can” in claims 1 & 8. Since Kawesch’s air flow module may be manually operated and manipulated (see lines 26-27 in col. 5), then regardless of its disclosed use, it “can” direct or is capable of directing a flow of air above the cornea of the patient from one side of the cornea to another side of the cornea, at a distance so that the cornea is not dehydrated by the flow of air.

Furthermore, Applicant argues that in Figure 4 of the Kawesch reference, the air flow from valve 206 would directly impinge the cornea. The examiner notes, however, that Applicant’s claim language does not exclude directing airflow onto the cornea of a patient and because none of the claim terminology is defined in the specification as excluding such airflow. Furthermore, if such a limitation were added to the claims, the claims would be drawn to new matter because the original disclosure does not support it. The specification

variously describes the airflow as: (1) flowing across the cornea (e.g. page 5, line 20); (2) flowing directly above the cornea (e.g. page 7, lines 10 and 11); and (3) not directly impinging the cornea (page 7, lines 11 and 12). None of these descriptions excludes airflow directed onto the cornea. Indeed, the use of "across" in description (1) indicates that the inventors contemplate airflow that is in frictional contact with the surface of the cornea as it flows "across" the cornea. Furthermore, the use of "directly" in description (3) strongly implies that the inventors contemplate airflow which incidentally, or indirectly, contacts the cornea, such as at a low angle, rather than at a "direct" angle. Apparently some airflow contact will not dehydrate the cornea as long as it does not directly impinge the cornea. In addition, the phrase "directly above" in description (2) indicates that the airflow is very close to the surface of the cornea, which it must be in order to reduce the amount of contaminants that may become attached to the cornea, as discussed at the top page 5. Airflow which is "directly above" a cornea is quite likely to contact the cornea, at least indirectly, and the applicants did not state that the airflow is far enough above the cornea to prevent any contact whatsoever. Since there is no clear description of airflow that is not directed onto the cornea, the original disclosure does not support a claim which excludes directing the flow of air onto the cornea of a patient.

Furthermore, Applicant argues that in the Kawesch reference, the cornea is dehydrated. And Applicant attempts to support this argument by including quotations from the Kawesch reference which disclose the term "drying". The examiner notes, however, that the drying is for the gutter area (see "gutter area" in line 24 of the abstract, also see "gutter area 22...FIG.5" in lines 43-52 of column 5, also see 22 in Fig.5 of Kawesch), not the entire corneal area.

Art Unit: 3743

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

**(12) Evidence Appendix**

No evidence was submitted by Applicant.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*rel rel*

Fadi H. Dahbour

Patent Examiner

Art Unit 3743

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